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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/020,587

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Kirk Beach

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EXAMINER

DURAN, ARTHUR D

ART UNIT

PAPER NUMBER

3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/020,587

Applicant(s)

BEACH ET AL.

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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DETAILED ACTION

1. Claims 1-26 have been examined.

Response to Amendment

2. The Amendment filed on 1/4/2007 is insufficient to overcome the prior rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett (6,321,208) in view of Kanter (5,537,314).

Claim 9, 1, 17, 26: Barnett discloses a method useable by at least a first plurality of consumers in connection with coupon redemption comprising:

storing, in at least a first service center, for each said consumer, first consumer identification information for said consumer and an account identification for at least a first account of said consumer (Fig. 9; Fig. 4a, Fig. 6, item 42; col 13, lines 52-60; col 7, line 55-col 8, line 5; col 12, line 14-65);

storing, in an electronic storage device at least first coupon information for each of a plurality of coupons, said first coupon information including a redemption value and a

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qualifying purchase identification, said first coupon information being accessible by at least one of said first service center computer and a point-of-sale computer system (Fig. 1, 2, 3, 5, 6; col 11, lines 29-44);

storing, in said point-of-sale computer system, a list of purchases made by each of a second plurality of consumers, and second identification information for each of said second plurality of consumers, at least some of said second plurality of consumers being members of said first plurality of consumers (Fig. 1; Fig. 9, 'Obtain User Data and Product Data'; col 8, line 17-21; col 1, lines 25-28; col 2, line 64-col 3, line 2; col 12, line 25-65);

comparing purchases in said list of purchases with said qualifying purchase identifications of said first coupon information (col 11, lines 29-44);

when a match is identified, defining a matched coupon and a matched consumer (col 11, lines 29-44); and crediting an amount, based on a redemption value of at least said matched coupon, in an account of said matched consumer (col 7, lines 11-20; col 4, lines 64-69; col 11, lines 29-44).

Barnett does not explicitly disclose depositing an amount.

However, Barnett discloses crediting an amount to a user at time of purchase (col 7, lines 11-20) and Barnett discloses providing electronic transfer of an amount to a user at time of purchase (col 4, lines 64-69; col 11, lines 29-44) and Barnett discloses the use of electronic cards (col 3, lines 11-25) and Barnett discloses that the user can be a member of online service providers (col 6, lines 35-42). And, Examiner notes that it is old and well known that online service providers have account information of users such as credit card account information or

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bank account information. Online service providers have this information in order to bill users for services provided.

And, Kanter discloses depositing an amount into an account of a user based on a coupon or rebate associated with a product (Fig. 1; col 16, line 37-col 17, line 25; col 9, line 30-47; col 12, lines 55-60; col 15, lines 18-25; col 18, lines 6-21).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Kanter's depositing an amount to Barnett's crediting an amount to a user for a redemption value for a matched coupon. One would have been motivated to do this in order to provide further convenience options for how the user receives the coupon/rebate amount.

Claim 2, 10, 19: Barnett and Kanter disclose the above and Barnett further discloses that said facilitating computer is said point of sale computer (col 11, lines 29-44; Fig. 1; col 12, line 65- col 13, line 10).

Claim 3, 11, 20: Barnett and Kanter disclose the above and Barnett further discloses that said facilitating computer is said service center computer (Fig. 1; col 12, line 65- col 13, line 10).

Claim 4, 12, 21: Barnett and Kanter disclose the above and Barnett further discloses that said consumer identification information includes information selected from the group consisting of mailing address (col 2, lines 23-33, col 4, lines 32-38) email address and password (col 13, lines 55-60; col 6, lines 37-43; fig. 4a) and other unique identifiers and social security number and online service address (col 7, lines 20-35).

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Also, Kanter discloses collecting bank and credit/debit information from a user as disclosed in the rejection of claim 1 above.

Barnett further discloses that other demographic information can be collected concerning a user (Fig. 9; Fig. 4a, Fig. 6, item 42; col 13, lines 52-60; col 7, line 55-col 8, line 5; col 12, line 14-65).

Also, Examiner notes that online service providers collect a wide range of demographic information concerning a user.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that a variety of demographic information can be collected concerning a user. One would have been motivated to do this in order to better target the user.

Claim 5, 13, 22: Barnett and Kanter disclose the above and Barnett further discloses that said list of purchases is obtained in response to a retail location check-out procedure (col 7, lines 11-20).

Claim 6, 14, 23: Barnett and Kanter disclose the above and Barnett further discloses that said electronic storage device is directly coupled to said service center computer (Fig. 1; col 12, line 65-col 13, line 10).

Claim 7, 15, 24: Barnett and Kanter disclose the above and Barnett further discloses that said service center computer is programmed to store identification of at least a first coupon selected by a consumer, associated with identification information of said consumer (Fig. 1; col 12, lines 25-col 13, line 10).

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Claim 8, 16, 18, 25: Barnett and Kanter disclose the above and Barnett further discloses that said first coupon is selected using an Internet communications link (Fig. 7; col 6, lines 29-51).

Response to Arguments

4. Applicant's arguments with respect to the claims have been considered but are not found persuasive.

In Applicant's Remarks dated 1/4/2007, Applicant states that Barnett or Kanter do not disclose "providing electronic transfer of an amount to a user at the time of purchase" or "depositing an amount based on a coupon in an account of a consumer".

However, Examiner notes that it is the combination of Barnett and Kanter that renders obvious the features of the Applicant's claims.

Also, Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to. Also, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

And, Examiner notes that it must be presumed that the artisan knows something about the art apart from what the references disclose. In *re Jacobv*, 309 F.2d 513, 135 USPQ 317 (CCPA 1962). The problem cannot be approached on the basis that artisans would only know what they read in references; such artisans must be presumed to know something about the art apart from

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what the references disclose. In re Jacoby. Also, the conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint of suggestion a particular reference. In re Bozek, 416 F.2d 1385, USPQ 545 (CCPA 1969). And, every reference relies to some extent on knowledge or persons skilled in the art to complement that which is disclosed therein. In re Bode, 550 F.2d 656, USPQ 12 (CCPA 1977).

Also, Examiner notes that the person of ordinary skill in the art is a hypothetical person who is presumed to know the relevant prior art. Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc., 807 F.2d 955,962, 1 USPQ2d 1196, 1201 (Fed. Cir. 1986).

In determining this skill level, the court may consider various factors including "type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field." Id., cited in In re GPAC, 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995). In a given case, every factor may not be present, and one or more factors may predominate. Id. at 962-63, 1 USPQ2d at 1201.

And, the combination of Barnett and Kanter does render the features of "providing electronic transfer of an amount to a user at the time of purchase" or "depositing an amount based on a coupon in an account of a consumer" obvious.

Examiner notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are

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given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

And, Examiner notes that Applicant's Specification discloses that coupons includes coupons and rebates, 'and the like' (Paragraph [0004]). Hence, a coupon or rebate can be read into the Applicant's coupon language. And, a coupon or rebate can be read into the relevant prior art. That is, the prior art can state coupons, rebates, or both and the prior art would be relevant.

And, as noted in the rejection, Barnett discloses that a user can electronically pay for a purchase and at the same time redeem a coupon online (col 4, lines 64-69; col 11, lines 29-44). Hence, the amount of the users coupon is credited towards the user's purchase electronically or online.

And, as noted above, Kanter discloses depositing an amount into an account of a user based on a coupon or rebate associated with a product:

"(37) (b) to provide an incentive program which can act as an advertising campaign for program sponsoring companies and which further reduces the need for coupon printing and collecting as participants can have rebates automatically applied to their accounts" (col 12, lines 55-60);

"(29) Another incentive plan available is shown by McCarthy's U.S. Pat. No. 5,202,826, issued Apr. 13, 1993. With this system, participants of the incentive program accumulate cash rebates in a holding account at a central center. The rebates are often based upon multiplying a merchant's predesignated or keyed in discount rate by a participant's purchase amount. Consumers can participate in multiple merchant incentive programs with the need for only one identification code number. All of a consumers cash awards earned from multiple merchants' programs accumulate in one account for the consumer" (col 9, lines 30-41).

And, Examiner notes that the features that Kanter refers to from McCarthy are old and well known as they appear in the 'Background' section of Kanter. And, Examiner notes that the

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features to which Kanter refers to in McCarthy as being old and well known explicitly discloses depositing an amount into an account of a user based on a coupon or rebate associated with a product:

“A centralized system of accumulating cash value for consumers based upon point-of-sale transactions with multiple merchants is disclosed wherein for each transaction, the consumer's account number (such as the Social Security number) which may be different from the consumer's credit card account number, for example, is transmitted to a central system along with data identifying the merchant and a credit value for the transaction. The credit value may be based upon predetermined incentives associated with the transaction such as coupons, rebates or discounts, and/or upon a credit rate determined by the merchant applied to the amount of the transaction. At the central location, a cash value for that consumer is incremented by the credit value and a bill value for that merchant is similarly incremented’ (McCarthy; 5,202,826; Abstract).

Additionally, Kanter discloses that awards can be coupons/rebates:

“Alternatively sponsoring companies can issue the awards to participants in the form of catalog merchandise, travel tour, cash, check, coupon, certificate or direct deposit into the participants' bank account. Sponsoring companies, without realizing any financial loss can also honor awards posted to participants' accounts by other sponsoring companies” (col 16, lines 46-53).

And, Examiner further notes that Kanter discloses redeeming awards:

“(41) (f) to provide a system wherein a participant can join in a merchant's multilevel selling campaign and/or incentive award program and redeem their earnings, and/or credit, and/or awards at the sponsoring company's location, as soon as the earnings, and/or credit and/or awards are posted, alleviating the need for check writing and mailing, and eliminating delays and other problems associated with such procedures” (col 13, lines 13-21).

And, Kanter discloses that redemption can comprise placing cash into a customer account (Fig. 1 and below citations):

“(46) (k) to provide an incentive award program which eliminates the problems associated with incentive programs which award cash, checks, coupons, or certificates to participants” (col 13, lines 35-40);

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“(77) (gg) to provide an incentive program which also allows a sponsoring financial institution to issue to participants, rebates that can be applied to their charge card for use in reducing the account balance or making any purchase, or which can be redeemed in cash, coupons, checks, catalog products, trips, goods or service from designated merchants, or any combination thereof” (col 15, lines 19-25);

“Likewise, financial institution award figures can be controlled by computer 60 or 30 in that they can be redeemed similarly, as shown above, at only certain locations, at any location, or at a single location; issued immediately by way of direct deposit into participant's bank accounts; or redeemed in such conventional manners (not shown) only on certain merchandise or services, or in cash, such as at an automated cash dispensing machine or similar, or used to reduce the balance of the participant's financial-institution-statement balance, or issued to participants periodically by way of check, coupon, certificate, or any combination thereof” (col 27, lines 4-15).

“(21)...Alternatively, an award-honored-payment-due balance can be created, incremented, reduced and stored in memory 42 in accordance with payment being possibly made from center 12 to the sponsoring company on a daily, weekly, monthly, or any other type of scheduled basis. Computer 60 might also instruct printer 62 to issue coupons checks or certificates on a certain or varied schedule which will allow deliverance of available credit to the appropriate participants. Further, computer 60 might instruct the transfer of funds and/or catalog and/or travel tour orders made by a participant to the appropriate vendors in order for the participant's award selection request to be fulfilled. All entries, donations, discounts and used credit may be accounted for in memory, 79, or 80 with itemized statements being created by printer 62 for deliverance to sponsoring companies, participants, or other third parties” (col 25, line 55-col 26, line 3).

Hence, Kanter discloses that awards can be coupons/rebates, the redeeming of awards, and that redemption can comprise placing cash into a customer account. Hence, Kanter discloses depositing an amount into an account of a user based on a coupon or rebate associated with a product.

Hence, Kanter discloses depositing an amount into an account of a user based on a coupon or rebate associated with a product (via the Background section of Kanter referring to

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McCarthy; and also Kanter, col 12, lines 55-60; and also the other citations from Kanter cited in this section preceding).

Hence, the combination of the prior art renders obvious depositing an amount into an account of a user based on a coupon or rebate associated with a product.

Hence, the combination of the prior art renders obvious the features of the Applicant's claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Arthur Duran
Primary Examiner
1/23/2007